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Attorney's Docket [redacted] 02103-406001 / AABOSS32

#8 PB 4/15/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Barret Lippey
Serial No. : 10/028,063
Filed : December 21, 2001
Title : SELECTIVE REFLECTING

Art Unit : 2851
Examiner : Christopher E. Mahoney

Hon. Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT

Dear Commissioner:

Responsive to the office action dated March 11, 2003, application owner respectfully traverses the requirement for restriction and provisionally elects claims 1-32, 41, and 51-68, in Group I.

35 U.S.C. §121 reads, "If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." Thus, restriction is proper only if the inventions are "independent and distinct." M.P.E.P. headed 802.01, "Meaning of 'Independent', 'Distinct' reads as follows:

INDEPENDENT

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect, for example, (1) species under a genus which species are not usable together as disclosed or (2) process and apparatus incapable of being used in practicing the process.

DISTINCT

The term "distinct" means that two or more subjects as disclosed are related, for example as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE (novel and

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> unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term "related" is used as an alternative for "dependent" in referring to subjects other than independent subjects.

The Examiner has not shown that the claims in each group "ARE PATENTABLE (novel and unobvious) OVER EACH OTHER." Should the requirement for restriction be made final, the Examiner is respectfully requested to rule that the claims in each Group "ARE PATENTABLE (novel and unobvious) OVER EACH OTHER."

The Examiner has made no showing whatsoever that the inventions are INDEPENDENT. M.P.E.P. 803 provides, "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

And M.P.E.P. 803.01 provides, "IT STILL REMAINS IMPORTANT FROM THE STANDPOINT OF THE PUBLIC INTEREST THAT NO REQUIREMENTS BE MADE WHICH MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION.

Manifestly, search and examination of the entire application can be made without serious burden because prior art related to the screen must be searched in connection with examining the claims in the other groups.

The Court of Customs and Patent Appeals has also recognized that "independent and distinct" means "independent and distinct." *In re Weber*, 198 U.S.P.Q. 328 (C.C.P.A. 1978); *In re Haas*, 198 U.S.P.Q. 334, 336 (C.C.P.A. 1978).

In a decision dated June 23, 1977, on a petition filed June 13, 1977, Group 1210 Director Alfred L. Leavitt in granting the petition to withdraw the requirement for restriction said:

> Current Office policy is not to require restriction between related inventions when no substantial burden is involved in the examination of all claims in a single application.

And in a decision dated 3 December 1993 on a petition filed March 12, 1993, Group 1100 Deputy Director John Doyle said:

> Restriction was required between (I)method for epitaxial deposition and (II)epitaxially deposited product (Paper No. 4). However, the examiner failed to present any convincing basis for the holding that the inventions as above grouped are distinct. The claimed inventions must be independent or distinct, and the examiner "must provide reasons and/or examples to support conclusions . . .". Further, the field of search for the alleged distinct inventions is seen to be coextensive, hence, no serious burden is seen to be incurred by examination of all pending claims. MPEP 803 under "Criteria For Restriction Between Patentably Distinct Inventions".
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> The Petition is GRANTED.

That claims 1-32, 41, and 51-68 are directed to a wavelength selective projection screen and all the claims are related as subcombinations usable together in a single combination has nothing to do with the requirements of establishing that the groups are both independent and distinct and that search and examination of the entire application cannot be made without serious burden. That the inventions are related precludes a ruling that the groups are independent and distinct.

Manifestly, search and examination of the entire application can be made without serious burden because prior art related to the claimed asymmetrically diffusing screen, a projector and a light projection system having a related projector and screen are likely to disclose subject matter which must be searched in connection with examining claims 1-21, 41, and 51-68. Accordingly, it is respectfully requested that the requirement for restriction be withdrawn. If the requirement for restriction is repeated, the Examiner is respectfully requested to rule that the claims in each group ARE PATENTABLE (novel and unobvious) OVER EACH OTHER and explain why all the claims cannot be examined without serious burden.

No fee is believed to be due. However, the Commissioner is respectfully requested to charge any fees to Deposit Account No. 06-1050, Order No. 02103-406001.

Respectfully submitted,

FISH & RICHARDSON P.C.

Date: APR 11 2003

Charles Hieken
Reg. No. 18,411

Fish & Richardson P.C.
225 Franklin Street
Boston, Massachusetts 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

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